

REMARKS

Support for the Amendment can be found in the specification, in the paragraph bridging pages 2-3 thereof and in the first full paragraph of page 3.

Reconsideration of the previous rejections of claim 5 under 35 U.S.C. §102(b) over Jugle; or claims 5 and 7 under 35 U.S.C. §102(e) over Tanikawa et al, is respectfully requested.

Although the rejections argue that the limitations of the claims are “inherently” found in these references, such is clearly not the case. Independent claim 5 requires that a liquid quaternary ammonium compound be mixed with an aqueous methylmethacrylate polymer base solution in an amount of 1 to 10 wt% based on the weight of the polymeric composition and a polyethylene wax in order to impart surface resistivity express as static dissipative property and conductive property. Neither Jugle or Tanikawa et al provide such a finding.

Jugle and Tanikawa et al are both directed to a toner composition. Although the toner may contain a charge enhancing additive, there is no teaching that any surface resistivity properties within the limits expressed by independent claim 5 can be found on the papers in either of the cited references. The fact that a property “might be found” to exist in the prior art, if the proper balance of components, formulation, diversity of coating, and method of application were found, does not make it “inherent” unless it is inevitable. See, MPEP 2112.

Similarly, Tomita et al, cited in a rejection of claims 5 and 7 under 35 U.S.C. §103(a) does not establish a *prima facie* case of obviousness for the claimed invention. While the Examiner assumes that the products “have identical chemical composition,” such an assumption is clearly erroneous. There is no teaching of the amount of the quaternary ammonium salt in Tomita et al, notwithstanding the Examiner’s reference to column 5, lines 32-38. Dependency on the amounts

included in the composition and the amount and manner of applying the composition to a paper, the resulting properties will vary, including the properties instantly claimed. Absent the suggestion provided in the specification seeking to limit the surface resistivity properties, one of ordinary skill in the art, viewing Tomita et al (even in view of Jugle as suggested in the body of the rejection) would not have been led to the claimed invention. As noted above, there is no “inherency” to the claimed properties merely because some of the components of the prior art overlap with the invention. The result must be inevitably, not merely possible. MPEP 2112.

Respectfully submitted,



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